

## REMARKS

In the Official Action dated July 19, 2000, the Examiner made the following rejections/objections to the present application:

1. The specification was objected to for failing to specifically identify the patent that issued from the application set forth on page 1, line 2.
2. The title of the present application was objected to as being non-descriptive of the claimed invention.
3. Claims 1(sic) - 7 and 9 are rejected under 35 USC 102(e) as being anticipated by Woodruff et al.
4. Claims 3 - 7 and 9 are rejected under 35 USC 102(f) in that the Examiner has asserted that the applicants are not the inventors of the subject matter in view of the patent to Woodruff et al.
5. Claim(s) 3-7 and 9 are rejected under 35 USC 102(b) as being anticipated by Brogden et al.
6. Claim 8 is rejected under 35 USC 103 as being unpatentable over Brogden et al.

At the time of the mailing of this Office Action, claims 3 - 9 were pending in the present application. In response to the Office action, claims 3 and 5 have been amended. Further, claim 4 has been canceled. After this amendment, claims 3 and 5-9 remain pending in the application.

### The Specification Objections

In connection with the objection to the specification, the specification has been amended in the manner suggested by the Examiner. Further, a chain of priority is claimed through USSN 09/300,610 and US Patent 5,980,706. Accordingly, it is submitted that the objections to the specification have been addressed. Withdrawal of the objections to the specification is therefore requested.

### The Objections to the Title

In response to the objections to the title, the title has been amended so that it more closely relates to the subject matter of this patent application. Withdrawal of the objections to the title is therefore requested.

### The Rejections under 35 USC 102(e) and 35 USC 102(f) in View of Woodruff Et Al.

The claims of the present application have been rejected under 35 USC 102(e) as being unpatentable over USP 6,080,291 to Woodruff et al. However, although the present application has a filing date of September 3, 1999, the subject matter of the claims of this application are supported by the parent application, now issued as USP 6,001,234. More specifically, for example, the Examiner's attention is directed to one of the embodiments of the present invention shown at Figure 22 of the '234 patent as well as the corresponding description found at columns 23 and 24. Further support for the claims of the present invention may also be found in the grandparent application added by the present amendment, USP 5,980,706. The '234 patent has a filing date of September 30, 1997 while the '706 patent has a filing date of July 15, 1996. The dates of both issued patents precede the July 10, 1998, filing date of Woodruff et al. As such, Woodruff et al does not constitute prior art to the present application. Withdrawal of the rejections under 35 USC 102(e) is therefore warranted.

Additionally, the fact that Woodruff et al. identifies a different set of inventors than the inventors named in the present application does not establish that the inventors named in the present application are not the true inventors of the claimed subject matter under 35 USC 102(f). Although the claims of the present application may read on the invention described in the later-filed Woodruff et al patent, the subject matter of the claims issued in the Woodruff et al patent constitute an improvement that is patentable over the present application. These improvements over the generic version of the invention set forth in the present claims were made at an earlier time by a different set of inventors than those who

invented the improvements claimed in Woodruff et al. No inferences with respect to the inventorship of the invention claimed in the present application can be drawn from the inventorship of the invention claimed in the Woodruff et al patent. Accordingly, withdrawal of the rejections under 35 USC 102(f) is respectfully requested.

It is also noted that the present application and the patent to Woodruff et al were commonly assigned to Semitool, Inc. at the times that the inventions of the present application and the patent were made. Further, the present application and the patent to Woodruff et al remain commonly owned by Semitool, Inc.

### The Rejections in View of Brogden Et Al.

#### *Claim 3*

As presently amended, claim 3 is directed to a contact assembly for supplying electrical power to a microelectronic workpiece during electrochemical processing of the workpiece. The assembly comprises an electrical contact for providing an electrically conductive connection between the contact assembly and the microelectronic workpiece. Further, the assembly includes a yieldable sealing member. The yieldable sealing member includes a rim portion that is proximate the electrical contact. The rim portion is adapted to bevel against the surface of the workpiece as the workpiece and contact assembly are brought into engagement with one another. This manner of engagement between the rim portion and the workpiece is particularly effective in sealing the contact from the electrolyte used in the electrochemical processing.

In contrast, Brogden et al. merely describes "a sealing ring" that purportedly seals against the surface of the workpiece. Notably, the reference fails to disclose or suggest any specific structure for the sealing ring. As such, the specific manner in which the sealing ring and the surface of the workpiece engage one another is left to the imagination. It is only after the present application is improperly used as a template to correct the deficiencies of the Brogden et al. reference that a person of ordinary skill in the art can arrive at the invention of claim 3.

### *Claim 5*

Claim 5 is dependent on claim 1 and provides added structure that defines the relative cooperation between the yieldable sealing member, its rim portion, and the electrical contact. More particularly, claim 5 states that the electrical contact is recessed with respect to the rim portion of the yieldable sealing member. Further, the yieldable sealing member deforms to enable the electrical contact to contact the surface of the microelectronic workpiece.

Brogden et al. is completely devoid of any teaching of the relative cooperation between its "sealing ring" and its contacts. If Figures 2 and 3 are used as a gauge for the relative size of the sealing ring 40 and its corresponding channel 42 then it becomes clear that the electrical contacts 36 extend well beyond the limit of the sealing ring and, thus, are not "recessed". Accordingly, the limitations added by claim 5 are patentable in their own right over Brogden et al.

### *Claims 6 and 7*

Claim 6 is dependent on claim 5 and adds further features of the cooperation between the rim portion of the yieldable sealing member and the surface of the microelectronic workpiece. More particularly, claim 6 states that the rim portion of the sealing member splays outward (away from the contact) when the yieldable sealing member deforms during contact with the surface of microelectronic workpiece.

Brogden et al, as noted above, is completely deficient in terms of how the "sealing ring" cooperates with the surface of the microelectronic workpiece. Accordingly, the features of claim 6 are likewise patentable in their own right over the Brogden et al. reference. This is likewise the case with respect to claim 7, which is dependent on claim 6.

### *Claim 8*

Claim 8 is dependent on claim 3 and adds the further feature of a bellows wall structure to the yieldable sealing member. The Examiner has admitted that this feature is not found in Brogden et al. However, the Examiner has nevertheless rejected this claim under 35 USC 103 as being directed to a "mere design choice." In support of this rejection, the

Examiner cites to the following CCPA decisions: *In re Dailey*, 149 USPQ 47 (CCPA 1966); *In re Rose*, 105 USPQ 237 (CCPA 1955); and, *In re Reven*, 156 USPQ 679 (CCPA 1968). It is submitted, however, that these cases are not applicable to the facts of the present situation. In each of the foregoing decisions, the Examiner found and applied prior art that included similar structures as well as the motivation to combine those structures to arrive at the invention claimed by each of the applicants. In the present instance, Brogden et al. does not include any structure for its "sealing ring" let alone any motivation to modify it to arrive at the invention of claim 8 or any other claim of the application.

It is submitted that the Examiner's statement that the invention of claim 8 is a "mere design choice" is insufficient to establish a prima facie case of obviousness under 35 USC 103. As stated by the Court of Appeals of the Federal Circuit in *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1995):

In a proper obviousness determination, "[w]hether the changes from the prior art are 'minor', . . . the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's . . . device." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir.), *cert. denied*, 498 U.S. 920 (1990). This includes what could be characterized as simple changes, as in *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.).

The Court then proceeded to overturn the decision of the BOPA holding that the differences between the prior art and the invention claimed by Chu constituted more than a "mere design choice" since there was no teaching or suggestion in the prior art to make the claimed modifications.

In the present instance, the Examiner has not identified any motivation in the Brogden et al reference that would lead a person of ordinary skill in the art to arrive at the invention claimed in the present application. Withdrawal of the rejection of claim 8 under 35 USC 103 is therefore respectfully requested.

To the extent that the Examiner relies on any extrinsic information and/or motivation to establish that claim 8, or any other claim of the present application is obvious ( i.e., a "mere design choice"), the Examiner is requested to provide an affidavit in accordance with 37 CFR 1.104(d)(2), which states in relevant part:

" When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicants, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavit of the applicants and other persons."

#### CONCLUSION

It is submitted that all of the claims of the present application are allowable over the art of record, taken singly or in combination, and that the application is therefore in condition for allowance. However, if there are any further unresolved issues in connection with this application, the Examiner is encouraged to contact Applicants' representative, Robert Polit, at the telephone number identified below.

Respectfully submitted,

BY



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